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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,141	04/06/2000	Heidi Karves	017.37566X00	9195
20457	7590	02/18/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			VANDERPUYE, KENNETH N	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/544,141	KARVES ET AL.	
	Examiner	Art Unit	
	Kenneth N Vanderpuye	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-28,30-36 and 40-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-16,30-32,34-36 and 46-49 is/are allowed.
- 6) ☒ Claim(s) 17,27,40-45,54,62 and 63 is/are rejected.
- 7) ☒ Claim(s) 18-28, 50-53, 55-63 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 27, 40, 41, 43, 45, 54, 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhodes(6,343,120) in view of Molne(5,689,547).

With regards to claims 17, Rhodes teaches a method for providing a terminal online access capability to at least a phonebook database of the system comprising:

Instructing the system to start a phonebook application, wherein for incoming calls the phone book application commences in response to a phone number identification at the user terminal (Fig. 1, terminal 113 has caller ID; when terminal 102 calls 113, the phone book application is activated, col. 1 lines 33-55), performing a search query of said phone book database to identify at least one of a caller corresponding to a phone number identification of an incoming call(col. 1 lines 48-55). Rhodes does

not teach the limitation “..and for outgoing calls the phone book application commences through a user interface of said wireless terminal... and performing a search query to said database to identify...at least one phone number and designation of an outgoing call to be made.” Molne teaches these features (col. 4 lines18-29, see abstract, the user initiates the search using telephone keys). It would have been obvious to combine Molne with Rhodes for the purpose of enabling telephone directory capability as well as caller ID via the phonebook database. The motivation being to provide a dual service to the user.

Claim 27 is rejected because the name database in Rhodes is a journal viewing application, and the results can be viewed in a wireless terminal(Fig. 3)

Claims 40, 54 are rejected for the same reasons as claim 17 because the phone book application(also considered a journal viewing application) is similar to that of claim 17. In addition Molne teaches at least one server(Fig. 4@25d, HLR) and a phone book database(Fig. 4@22d, also a journal database), one wireless terminal operably connected to the network(Fig. 4@16d), at least one transport interface...(Fig. 4@18d). It would have been obvious to combine Molne with Rhodes for the purpose of

enabling telephone directory capability as well as caller ID via the phonebook database. The motivation being to provide a dual service to the user.

With regards to claim 41, it is well known in the art that for a terminal to be able to access a database, uninterrupted accessibility and required as well as the protocol necessary to achieve this connection. It would have been obvious.

Claim 43 is rejected because the terminal in Molne is a wireless terminal.

Claims 45, 63 are rejected because the wireless terminal in Molne has a display capability and voice capability. The use of a head set is now an optional feature in most cell phone. The motivation being free hands during driving.

Claims 42, 44, 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhodes(6,343,120) in view of Molne(5,689,547) as applied to claim 40 above, and further in view of Enzman et al.(6,516,203)

With regards to claim 42, Molne and Rhodes fail to teach a WAP application. This is taught by Enzmann(Fig. 1). It would have been obvious to combine this feature with Molne, Schmidt and Rhodes for the purpose of

wireless accessing a name database on the internet. The motivation being to enable calls over the internet.

Claims 44, 62 are rejected because official notice is taken that it is well known that WAP is capable supporting VOIP. Hence it would be obvious to combine this well with Enzman for the purpose of enabling voice calls over the internet. The motivation being to avoid PSTN charges.

Allowable Subject Matter

Claims 5-28, 30-32, 34-37, 40-63 are allowed.


Claims 18-28, 50-53, 55-63 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth N Vanderpuye whose telephone number is 703-308-7828. The examiner can normally be reached on M-F(7:30-5:00) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

KNV
2/15/04



KENNETH VANDERPUYE
PRIMARY EXAMINER